

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| In re Application of: |) | |
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| Daisuke TENMIZU et al. |) | Group Art Unit: 1634 |
| |) | |
| Application No.: 10/536,809 |) | Examiner: Jeanine Anne GOLDBERG |
| |) | |
| 371(c) Date: May 27, 2005 |) | |
| |) | |
| International Filing Date: May 28, 2004 |) | Confirmation No.: 4582 |
| |) | |
| For: CANINE CYP1A2 GENETIC |) | |
| POLYMORPHISM |) | |

MAIL STOP AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

AMENDMENT AFTER ADVISORY ACTION

Applicants now respond to the Advisory Action mailed January 10, 2008. The period for reply has been extended to March 10, 2008 by the Petition for Two Month Extension of Time and requisite fee filed herewith. Applicants respectfully request entry of the following amendments and consideration of the following remarks. Applicants also respectfully request reconsideration and withdrawal of all outstanding objections and rejections.

Amendments to the Claims begin on page 2 of this paper.

Remarks/Arguments begin on page 4 of this paper.

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions and listings of claims in the application:

1. (Canceled)
2. (Currently amended) A method for determining whether a beagle dog is an extensive metabolizer or a poor metabolizer in the rate of drug metabolism, said method comprising:
 - preparing a nucleic acid sample from a beagle dog,
 - analyzing ~~a base corresponding to~~ a base at position 1179 of the nucleotide sequence of SEQ ID NO: 22,
 - determining a CYP1A2 genotype at the base ~~corresponding to the base~~ at position 1179 of the nucleotide sequence of SEQ ID NO: 22, and
 - judging the beagle dog with a C/C genotype or a C/T genotype to be an extensive metabolizer and the beagle dog with a T/T genotype to be a poor metabolizer.
3. (Previously presented) A method for selecting a beagle dog used in a medicament test, comprising
 - determining whether a beagle dog is an extensive metabolizer or a poor metabolizer in the rate of drug metabolism by the method according to claim 2, and
 - selecting a beagle dog with a C/C genotype or a C/T genotype as the extensive metabolizer or a beagle dog with a T/T genotype as the poor metabolizer.

4. (Previously presented) A method for assaying a pharmacological effect and/or toxicity of a test drug, comprising

administering a test drug to an extensive metabolizer group or a poor metabolizer group selected by the method according to claim 3, and

assaying a pharmacological effect and/or toxicity of the test drug.

5 - 9. (Canceled)

10. (Previously presented) The method according to claim 3, wherein a beagle dog with the C/C genotype is selected.

11 - 14. (Canceled)

REMARKS

Applicants appreciate the courtesy extended to Applicants' representative in the telephone interview of February 19, 2008. In the interview, Applicants' representative suggested claim language that should put the claims in condition for allowance. The Examiner very kindly agreed to consider the proposed amendment and accompanying Information Disclosure Statement.

Thus, in order to place this application in better form for allowance, claim 2 has been amended as discussed with the Examiner. Claims 1, 5-9, and 11-14 were previously canceled without prejudice or disclaimer. Applicants reserve the right to pursue the canceled subject matter in future applications. With the entry of this amendment, claims 2-4 and 10 are pending in this application.

Claim 2 has been amended to delete recitation of "a base corresponding to" as discussed with the Examiner.

These amendments add no new matter. Accordingly, Applicants respectfully request reconsideration of the application.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully request entry by the Examiner of this Amendment under 37 C.F.R. § 1.116, reconsideration of this application, and the timely allowance of claims 2-4 and 10. The proposed amendment of claim 2 does not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships were either claimed earlier or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

Finally, Applicants submit that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims. If this amendment does not put the case in consideration for allowance, Applicants respectfully request that the Examiner contact the undersigned at (650) 849-6607.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: February 20, 2008

By: Jean Burke Fordis
Jean Burke Fordis
Reg. No. 32,984
Customer No. 22,852